



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,957	06/18/2001	Rose Ramon Botella Mesa	229752001300	3466

7590 03/01/2006

Barry E Bretschneider  
Morrison & Foerster  
2000 Pennsylvania Avenue NW  
Washington, DC 20006-1888

EXAMINER

MARVICH, MARIA

ART UNIT PAPER NUMBER

1633

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/763,957	<b>Applicant(s)</b> ROSE RAMON BOTELLA MESA	
	<b>Examiner</b> Maria B. Marvich, PhD	<b>Art Unit</b> 1633	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: 11-14.  
 Claim(s) rejected: 1,7,9,15 and 19-24.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: The proposed amendment would raise the following new issues that would require new consideration: Claims 11-14 have previously been objected to for lack of reference to multiple dependent claims in the alternative and were said not to be further examined. As such examination of for example methods of altering plant characteristics consideration of would raise new issues that would require new consideration. Furthermore, claims 1, 7 and 15 have been amended to recite that the promoter directs expression of a gene encoding ACC synthase and wherein the promoter is inducible in response to physical stimulation. While this limitation has been examined in previous claim sets, it has not been examined in relationship to the limitations that the promoter comprises a fragment of +1 to -368 or a promoter related to SEQ ID No:3 or -1 to +368 by 90% identity or a promoter capable of hybridizing under the recited conditions.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants state that deletion of the phrase "at least" from the claim should obviate the new matter rejection as the SEQ ID NO:3 is disclosed in full. Applicants have not amended claims 1, 7, 9, 11 and 19-24 to overcome the rejection under 35 USC 112, first paragraph for new matter. The claim recites a fragment of SEQ ID NO:3, the fragment is said to comprise residues +1 to -368. However SEQ ID NO:3 is comprised of residues 1 to 2474 and cannot possibly comprise -368. -368 is a designation limited to the gene and not a construct such as SEQ ID NO:3.

Additionally, applicants argue that by provision of the functional characteristics "wherein in its native form the promoter directs expression of a gene encoding" the written description argument is overcome as the specification describes promoters with the claimed combination of structural and physical characteristics. Applicants arguments filed 2/9/06 have been considered but are not persuasive. The rejection under 35 USC 112, first paragraph is based upon a lack of written description for the broad genus of promoters that are encompassed by recitation of "sequences with at least 90% identity" or sequences "hybridizable under stringency conditions of 2X, 0.1% SSC at 45C". In fact, the specification lacks relevant structural characteristics by disclosure of a single species.



**DAVE TRONG NGUYEN**  
**SUPERVISORY PATENT EXAMINER**